

## REMARKS

Claims 1 and 5-8 are pending in this application. Claims 1, 5 and 7 are independent. The claims have not been amended, but the specification has been amended.

### **Impropriety of making the First Office Action be Final**

The April 4, 2006 Office Action, although a first Office Action, was made Final. In paragraph 8, the Examiner cited MPEP 706.07(b) for the propriety of doing this.

Applicant traverses the finality of the first Office Action. MPEP 706.07(b) reads,

**However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised. (emphasis added)**

In the Advisory Action dated February 17, 2006, the Amendment After Final was denied entry because “it would raise new issues that would require further consideration and/or search” (see checkmark for box 3(a)).

Thus, the reason for non-entry of the Amendment After Final, which was submitted along with the Request for Continued Examination as a Preliminary Amendment, precludes the Examiner from making the first Office Action be final, according to MPEP 706.07(b).

Withdrawal of the finality of the First Office Action is requested.

### **Basis in the specification for what is claimed**

In paragraph 2 of the Office Action, the specification was objected to as failed to provide proper antecedent basis for the claimed subject matter, as the term “devoid of an enclosing hem” was not found in the specification.

The specification has been amended to include the term “devoid of an enclosing hem”.

No new matter has been added.

“New matter is that which is not found in the specification, *drawings*, or model, as first filed, and which involves a departure from the original invention.” *In re Oda*, 443 F.2d 1200, 1203-4 (C.C.P.A. 1971) (citing Robinson on Patents) (emphasis added). “[D]rawings alone may provide a ‘written description’ of an invention as required by § 112.” *Vas-Cath, Inc. v. Makurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991). “[T]he test of whether ‘new matter’ exists is by reference to the written description and the drawings filed in the application.” *Shaffer Tool Works v. Joy Mfg.*, 424 F.Supp. 1269, 1274 (S.D. Tex. 1976). “Although [the Applicant] does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989) (citations omitted). “[T]he test for sufficiency of support ... is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983)).

Figs. 2-4 show that attachment strip 22 and attachment strip 24 are sewn to zipper flaps 14 and 16, respectively, without an enclosing hem that encloses the attachment seam respectively attaching the attachment strips 22, 24 to the rest of the garment. (“Inclusion of a negative limitation should not, itself, be considered a sufficient basis for objection or rejection of a claim.” MPEP 706.03(d)). Figs. 2-4 allow a person of ordinary skill in the art to recognize that there is no enclosing hem in the zipper fly construction of the present invention, and convey that the

present inventor had possession of attachment strips devoid of an enclosing hem. Thus, the claim language is supported by the originally filed disclosure.

MPEP 2163.06 states “Stated another way, information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.” See also *In re Benno*, 768 F.2d 1340, 1345 (Fed. Cir. 1985) (where a patent application as filed contains a claim which specifically discloses something not disclosed in the descriptive part of the specification, the applicant may amend the specification without being charged with adding new matter) (citing 37 CFR 1.118 (all amendments to the specification, including the claims, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of filing the application)). Therefore, the additional language to the specification is not new matter.

Withdrawal of the objection to the specification is requested.

**Advantages of an invention’s features do not have to be stated in the specification; each and every feature of a claim is critical and cannot be ignored**

At the top of page 4 of the Office Action, the Examiner states,

It would have been obvious to have provided the first and second attachment strips being devoid of an enclosing hem or having an enclosing hem, because as long as the attachment strips are attached to the first and second zipper flaps and provide a reversible fly structure[,] the presence or not of an enclosing hem does not effect [*sic*, should be affect] the reversibility of the zipper structure and therefore can be there or not. There is no discussion in the originally filed disclosure detailing the criticality or advantage of the first and second attachment strips being devoid of an enclosing hem.

In paragraph 7 of the Office Action, the Examiner stated that,

the attachment strips being devoid of an enclosing hem is not discussed in the specification detailing why it is critical to the invention or an advantage to the invention over other embodiments. Since the originally filed disclosure is silent on the first and second attachment strips being devoid of an enclosing hem, then the presence of an enclosing hem or the non-presence of an enclosing hem is not critical to the invention as long as the first and second attachment strips are attached to zipper flaps and provide a reversible zipper fly construction.

The Office Action provides no citation to a statutory provision, regulation, section of the MPEP or case law as legal support. Further, there is no rejection or objection to the claim or specification citing any statutory provision supporting the above quoted statements in the Office Action.

The Examiner seems to be asserting that because the significance of the attachment strips being devoid of an enclosing hem is not argued in the specification, this limitation can be ignored.

Further, the Examiner seems to be taking the position that an applicant for patent cannot argue during prosecution that claimed structure originally disclosed in an application has advantages over the prior art, if those advantages were not explicitly stated in the originally filed disclosure.

There is no legal support for either of these positions as explained in detail below.

There is no legal requirement that the specification explicitly state all advantages of a disclosed structure or that an applicant be precluded from arguing those advantages during prosecution of the patent application.

“To require [an applicant] ... to include evidence and arguments in the specification ... would be to require patent applicants to divine the rejections the PTO will proffer when patent applications are filed.” *In re Chu*, 66 F.3d 292, 298 (Fed. Cir. 1995) (none of the arguments would require any change in the construction of the disclosed apparatus). “We found no cases supporting the position that a patent applicant’s evidence and/or arguments traversing a § 103 rejection must be contained within the specification. There is no logical support for such a proposition as well, given that obviousness is determined by the totality of the record including, in some instances most significantly, the evidence and arguments proffered during the give-and-take of ex parte patent prosecution.” *Id.* at 299.

See also *In re Zenitz*, 333 F.2d 924, 928 (C.C.P.A. 1964)(evidence and arguments that claimed compound minimized side effects of hypotensive activity must be considered because this undisclosed property would inherently flow from use of compound as a tranquilizer). “[T]he mere failure of a patentee to realize all the benefits and possibilities of his invention is not fatal.” *Id.* at 927. “By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.” *In re Reynolds*, 443 F.2d 384, 388 (C.C.P.A. 1971); *In re Smythe*, 480 F.2d 1376, 1384 (C.C.P.A. 1973).

For the present invention, the fact that the first and second attachment strips are devoid of an enclosing hem means that there is less unsightly and/or uncomfortable bulk in the groin area. Absence of bulkiness in the groin area means that the garment is more comfortable to wear, and does not present an artificial bulge that might attract ridicule to the garment’s wearer. These are

advantages of the present invention over the prior art and must be considered in assessing the issue of obviousness under the “totality of the record” test stated in *In re Chu*.

### **Prior Art Rejections**

In paragraph 4 of the Office Action, claims 1, 5 and 6 were rejected as anticipated by U.S. Patent No. 3,234,564 (Chujfi).

Claim 1 is directed to an improved reversible zipper fly cover comprising a zipper having a first attachment strip opposite a second attachment strip. First and second panel zipper flaps are respectively connected to the first and second attachment strips by first and second attachment seams, *each of the first and second attachment strips being devoid of an enclosing hem*. First and second fly cover flaps are formed by respectively attaching the first and second panel zipper flaps to first and second panels by first and second fly cover finish seams.

*Each of Chujfi's zipper attachment strips is enclosed by a respective hem 40* (Fig. 3, column 3 lines 1-8). Enclosing the attachment strips in the hem produces a tailored appearance, which Chujfi apparently desired. Accordingly, Chujfi teaches away from the invention of claim 1.

Chujfi's hem creates at least one additional layer of fabric for each side of the reversible zipper assembly as compared to the claimed invention. If the fabric lacks an edge that will ravel, such as leather, then the hem is one additional layer. If the fabric is woven or otherwise has an edge that will ravel, then the hem's lengthwise edge must be turned under, creating two additional layers of fabric, one for the hem and one for the turned-under edge, relative to the claimed invention. Chujfi's additional layers of hem fabric, at least one on each side of the reversible zipper assembly, make Chujfi's garment bulkier than a garment according to the present invention.

For the present invention, the fact that the first and second attachment strips are devoid of an enclosing hem means that there is less unsightly and/or uncomfortable bulk in the groin area. Absence of bulkiness in the groin area means that the garment is more comfortable to wear, and does not present an artificial bulge that might attract ridicule to the garment's wearer. These are advantages of the present invention over the prior art and must be considered in assessing the issue of obviousness under the "totality of the record" test stated in *In re Chu*.

Claim 5 is a method claim generally corresponding to claim 1, and is not made obvious by Chujfi for the reasons described above. Claim 6 depends from claim 5, and so incorporates its features that patentably distinguish from Chujfi.

Withdrawal of the rejection of claims 1, 5 and 6 under 35 USC 102 is requested.

In paragraph 6 of the Office Action, claims 7 and 8 were rejected under 35 USC 103 as being unpatentable over Chujfi and GB Patent No. 2,153,656 (Vaghela).

Claim 7 is directed to a reversible garment with a reversible fly, comprising first and second panel zipper flaps respectively attached to first and second panels of the reversible garment, the second panel zipper flap having the same shape as the first panel zipper flap. A zipper having a reversible traveler guide is located between the first and second panel zipper flaps, the zipper having first and second attachment strips respectively affixed to the first and second panel zipper flaps by first and second attachment seams, each of the first and second attachment strips being devoid of an enclosing hem.

Vaghela was cited as showing a zipper with a reversible traveler guide. The proper combination of Chujfi and Vaghela is to replace Chujfi's two zipper traveler guides with Vaghela's one reversible traveler guide, which, while an improvement that reduces bulk, does

not eliminate the bulk due to the additional layers of Chujfi's enclosing hems. Accordingly, claim 7 is patentably distinguished from any proper combination of Chujfi and Vaghela.

Claim 8 depends from claim 7, and so incorporates its features that patentably distinguish from Chujfi.

Withdrawal of the rejection of claims 7-8 under 35 USC 103 is requested.

It is respectfully requested that this patent application pass to issue. A Notice of Allowance is solicited.

Please call the undersigned if there are any questions.

Respectfully submitted,

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Brenda Pomerance

Brenda Pomerance  
Reg. No. 36,894

Address:  
Law Office of Brenda Pomerance  
260 West 52 St. Ste. 27B  
New York, NY 10019  
voice/fax 212 245-3940